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09/977,754	10/15/2001	Joseph A. Orr	5072US	2866

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EXAMINER

MALLARI, PATRICIA C

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/977,754

Applicant(s)

ORR ET AL.

Examiner

Patricia C. Mallari

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 15, 19, 20 and 24 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 16-18 and 21-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: \_\_\_\_\_

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### ***Drawings***

The formal drawings were received on 2/4/02. These drawings are approved.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 1 recites a breathing apparatus (line 3) and a mouthpiece (line 4) as being two separate items; however, the specification discloses the breathing apparatus as being the same as the mouthpiece (see p. 6, paragraph 24). Also, claim 2 recites that the breathing apparatus is a mouthpiece. The specification does not disclose an embodiment of the invention comprising two mouthpieces.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: "apparatus for monitoring" on line 5 of the claim should be replaced with "an apparatus for monitoring". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-3, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Broadhurst et al. Broadhurst teaches a breath collection system comprising a breathing apparatus 144 and conduit 145 coupled to mouthpiece 144 at one end and to respiration monitoring apparatus 12 at the other. Conduit 145 maintains a desired configuration (engaged with respiration monitoring apparatus 12) until placed in another desired configuration (disengaged from respiration monitoring apparatus 12). The breathing apparatus 144 is a mouthpiece 144 configured to be at least partially inserted into the mouth of the user. Conduit 145 is an elongate compliant member (figs. 1, 2, 5, and 6).

Claims 1-4, 6-11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaston, IV et al. Gaston describes a breath collection system comprising conduit 5, 6 coupled to breathing apparatus 1 at one end and respiration monitoring apparatus 10 at another end. Breathing apparatus 1 is a mouthpiece that has an inlet valve 2 and outlet valve 3. Inlet valve 2 is a one-way valve facilitating the introduction of gases for inhalation, and outlet valve 3 is a one-way valve facilitating the evacuation of expiratory gases from the breathing apparatus 1. The end of mouthpiece 1 containing outlet valve 3 is a conduit coupling section, coupled to the first end of the conduit 5, 6, and downward from the breathing end of the mouthpiece 1. Conduit 5, 6 will maintain a desired configuration, such as attachment to respiration monitoring apparatus 10, until placed in another desired configuration, such as detachment from respiration monitoring apparatus 10 (fig. 1).

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Claims 1, 2, 5, 14, 15, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Murdock et al. Murdock discloses a breath collection system comprising a breathing apparatus 30 communicating with a user's mouth, and a conduit 26 coupled to the mouthpiece 30 at one end and to respiration monitoring apparatus 6 at the other end. The conduit 26 maintains a desired configuration (engaged with patient interface 24) until placed in another configuration (disengaged from patient interface 24). The breathing apparatus 30 is preferably a face mask, and conduit 26 is an elongate compliant member. In use, the patient wears the mask 30 while asleep, or in a resting position (fig. 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murdock et al. in view of Mault. Murdock lacks restricting respiration through a nose of the individual. However, Mault shows that a mouthpiece 12 and nose clamp 14 may be used in place of a mask that engages the nose as well as the mouth (col. 4, lines 1-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a mouthpiece and nasal clamp in place of the nasal mask of Murdock et al., since Mault discloses the combination of the nasal clamp and the mouthpiece to be functionally equivalent to a nasal mask.

***Allowable Subject Matter***

Claims 12, 13, 16-18, and 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: Regarding the allowability of claims 12, 13, 16, 17, and 21, the prior art does not teach or suggest a breathing conduit having at least a section with a longitudinally expandable and collapsible member. Regarding the allowability of claim 18, the prior art fails to teach or suggest a breathing conduit wherein at least a section carries at least one elongated compliant member configured to be bent to shape and maintain a desired configuration of the member. Regarding the allowability of claim 23, the prior art fails to teach a conduit that partially supports the breathing apparatus upon manipulating at least a portion of the conduit into a desired configuration.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,419,634 to Gaston, IV et al.

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US Patent No. 5,826,577 to Perroz, Jr. et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia C. Mallari whose telephone number is (703) 605-0422. The examiner can normally be reached on Mon-Fri 9:30 am-7:00 pm (alternate Fri. off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Pcm

*Robert S. Nasser*  
**ROBERT S. NASSER**  
**PROF. ST. ENGINEER**